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38A → DRC

| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|--------------------------|
| 08/182,183 | 05/23/94 | LIN | L SYNE225/C4-U S-225E |

U.S. PATENT OPERATIONS/DRC
M/S 10-1-B-431
AMGEN INC.
ONE AMGEN CENTER DRIVE
THOUSAND OAKS CA 91320-1789

HM21/0319

| EXAMINER | |
|----------|--------------|
| ALLEN, M | |
| ART UNIT | PAPER NUMBER |
| 1645 | 36 |

DATE MAILED: 03/16/98

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

Previously docketed
NOA - 6/11/98

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run 3 mo or continues to run from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response is filed and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension pursuant to 37 CFR 1.136 will be calculated from the date of the original or shortened statutory period for response or as set forth in the notice.

☐ Applicant's amendments are not deemed to overcome 37 CFR 1.192(a).

☒ Applicant's response to the final rejection filed 3/10/98 has been considered with the following effects being deemed to place the application in condition for allowance:

The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- a) ☒ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b) ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c) ☒ They raise the issue of new matter. (See Note).
- d) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e) ☒ They present additional claims without cancelling a corresponding number of finally-rejected claims.

NOTE: Applicant proposes adding claims 159-177 and cancelling Claim 93. The new claims would require further consideration as to basis in the specification and enablement. Amendments to pending claims would also require further consideration. It is particularly noted that the hybridization conditions recited in at least claims 119, 121, and 125 do not exactly match those set forth in Example 2 on page 58. There is no range of 40-50 °C or from temperature to 70 °C specified in addition these conditions are disclosed with reference to a particular probe (Seq 107) and not generally to the sequences recited in the claims. This continues to raise the question of new matter as set forth in the prior Office action. Applicant has not responded to this.

2. ☐ Newly proposed or amended claims 119, 121, 125 would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: 88-94, 118-120, 135, 150, 152-157
Claims objected to: NONE
Claims rejected: 117, 121-134, 136-149, 151, 158

However;

☐ Applicant's response has overcome the following rejection(s):

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because this.

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☒ has not been approved by the examiner.

☒ Other Pursuant to the changes to patent practice and procedure effective 10/1/97 concerning examiners' answers after appeal, this amendment will not be entered as it would require setting forth new grounds of rejection due to the proposed amendments.

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